

REMARKS

Claims 1-9 and 11-37 have been rejected by the Examiner. Claim 10 has been objected to as being dependent upon the rejected based claim 1, but would be allowable if rewritten in independent form. Applicants thank the Examiner and would like to take the allowance.

Claims 1, 12-14, 16, 18, 20, 22, 27-32, 34, and 35 have been amended, and claims 10, 15, 33, and 36-37 have been cancelled. Reconsideration of the application is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In “Claim Rejections – 35 USC § 112” item 1 on page 2 of the above-identified Office Action, claims 23 has been rejected. In particular, the Examiner states that the element “the second device” lacks sufficient antecedent basis in the claim. However, Applicants respectfully submit that the antecedent basis for such an element can be found in line 4 of claim 23, “a second device selectively coupled with...” Therefore, Applicants respectfully submit that claim 23 fulfills the requirement of 35 USC § 112.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101

In “Claim Rejections – 35 USC § 101,” on page 2 of the above-identified Office Action, claims 27, 32, 36 and dependent claims have been rejected as being directed to non-statutory subject matter.

Claims 33 and 36-37 are cancelled, which renders their rejections moot.

Even though Applicants do not agree with these rejections, claims 27, 32 and their dependent claims have been amended to expedite prosecution. Claims 27 and 32 now recite a storage medium having a plurality of programming *instructions* configured to program a machine.

Claims such as claims 27 and 32 are often referred to as “Beauregard claims”, in reference to the Federal Circuit Court’s decision in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995), in which the Federal Circuit held that a computer-readable storage device, e.g., a floppy disk or CD, containing a set of instructions that causes a computer to perform a

process is patentable subject matter. The court held that such instructions, stored on an article, are not merely “printed matter” (i.e., software per se) and are accordingly patentable. Because claims 27 and 32 recite precisely the sort of article of manufacture that was held to be patentable under §101 in *Beauregard*, claims 27 and 32 are patentable under §101. Accordingly, their dependent claims are also patentable under §101 for the same reasons.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

1. In “Claim Rejections – 35 USC § 103” item 3 on page 4 of the above-identified Office Action, claims 1-9, 11, 27-31, 36 and 37 have been rejected as being unpatentable over U.S. Patent Application Publication No. 2003/0217136 (hereinafter Cho), in view of U.S. Patent Application Publication No. 2003/0217165 (hereinafter Buch), in view of U.S. Patent Application Publication No. 2005/0111382 (hereinafter Le), further in view of the article “UPnP™ Security Ceremonies Design Document 1.0” authored by Ellison and published by the UPnP Forum (hereinafter Ellison) under 35 U.S.C. § 103(a).

Claims 36 and 37 have been cancelled, which renders their rejections moot.

Independent claim 1 is amended to recite features from claim 10 which is deemed allowable by the Examiner. Applicants submit that the amended claim 1 is therefore patentable over the combination of prior art references cited above under 35 U.S.C. § 103(a).

Claim 27 recites in essence the same as claim 1. Claims 2-9, 11, and 28-31 depend from claims 1 and 27 respectively, incorporating their recitations. Therefore, due to at least above stated reasons, claims 2-9, 11 and 27-31 are patentable over the combination of Cho, Buch, Le and Ellison under 35 U.S.C. § 103(a).

2. “Claim Rejections – 35 USC § 103” item 4 on page 10 of the above-identified Office Action, claims 12, 15-20, 22 and 32-34 as being unpatentable over Cho, Buch, IETF draft “Simple Service Discovery Protocol/1.0” (hereinafter IETF-Draft-SSDP), and Ellison under 35 U.S.C. § 103(a).

Claims 15 and 33 have been cancelled, which renders their rejections moot.

Independent claim 12 is amended to recite

“a method for a second device communicating with a first device on the internal network by way of an intermediary selectively coupling an external network and the internal network, comprising:
receiving, by the second device while on the internal network, a presence advertisement for the first device;
storing, by the second device while on the internal network, a network address associated with the first device;
determining, by the second device while on the internal network, services offered by the first device; and
issuing, by the second device while on the external network, a secure communication initiation request to the first device via the intermediary.”

Thus, read as a whole, claim 12 recites a method for a second device which moves between the internal and external networks to communicate with a first device on the internal network via an intermediary.

The Examiner cites paragraphs [0039], [0015] and Fig.7 of Cho and section 5.2.1.1 of IETF-Draft-SSDP as teaching most of the elements in claim 12. However, Cho and IETF-Draft-SSDP fail to teach or suggest that the UPnP client (which is deemed by the Examiner as the second device in claim 12) roams between the home network and the external Internet network, and performs the operations of the method correspondingly, as recited in amended claim 12.

Buch is cited as teaching an end-to-end authentication mechanism, and Ellison is cited as teaching the need for a security model which need was recognized by the UPnP Forum, and in combination as teaching the request for the initiation of a secure communication session in claim 12. However, Buch and Ellison fail to cure above stated deficiencies of Cho and IETF-Draft-SSDP.

Therefore, Applicants submit that the combination of Cho, Buch and Ellison fails to teach or suggest each and every element of claim 12 and claim 12 is patentable over Cho, Buch, IETF-Draft-SSDP and Ellison under 35 U.S.C. § 103(a).

Claim 32 recites in essence the same as claim 12. Claims 16-20, 22, and 34 depend from claims 12 and 32 respectively, incorporating their recitations. Therefore, at least due to above discussed reasons, claims 16-20, 22, 32 and 34 are patentable over Cho, Buch, IETF-Draft-SSDP and Ellison under 35 U.S.C. § 103(a).

3. Claim Rejections – 35 USC § 103” item 5 on page 14 of the above-identified Office Action, claims 13 and 14 as being unpatentable over Cho, Buch, IETF-Draft-SSDP, Ellison, and Le under 35 U.S.C. § 103(a).

Claims 13 and 14 depend from amended claim 12, incorporating its recitations. The firewall in Le is cited as teaching elements with regards to the filter of the intermediary in claims 13 and 14. However, Le fails to cure the above stated deficiencies of Cho, Buch, IETF-Draft-SSDP and Ellison. So, claims 13 and 14 are patentable over Cho, Buch, IETF-Draft-SSDP, Ellison, and Le under 35 U.S.C. § 103(a).

4. Claim Rejections – 35 USC § 103” item 6 on page 15 of the above-identified Office Action, claim 21 as being unpatentable over Cho, Buch, IETF-Draft-SSDP, Ellison and IETF RFC 3056, “Connection of IPv6 domains via IPv4 clouds” (hereinafter RFC 3056) under 35 U.S.C. § 103(a).

Claim 21 depends from claim 12, incorporating its recitations. RFC 3056 is cited as teaching “the network address associated with the first device is a globally unique network address having an address portion identifying the intermediary” by using the prefix of a globally unique IPv6 address to identify an intermediary that connects an IPv6 cloud to the IPv4 network. However, RFC 3056 fails to cure the above stated deficiency of Cho, Buch, IETF-Draft-SSDP and Ellison. So, claim 21 is patentable over Cho, Buch, IETF-Draft-SSDP, Ellison and RFC 3056 under 35 U.S.C. § 103(a).

5. Claim Rejections – 35 USC § 103” item 7 on page 16 of the above-identified Office Action, claims 23, 25 and 26 as being unpatentable over Cho, Buch, and Ellison under 35 U.S.C. § 103(a).

Claim 23 recites “a system of devices communicatively coupled with an internal network and an external network via a gateway, comprising:

a first device, communicatively coupled to the internal network, offering services;
a second device selectively coupled with the internal and external networks, the second device seeking a service of the first device, wherein when requesting the service, said requesting includes sending a secure communication initiation request to the first device to facilitate establishing a secure communication session with the first device; and
an intermediary selectively communicatively coupling the first and second devices, wherein the intermediary is configured to receive a secure communication

initiation request from the second device over the external network and forward the request to the first device.”

Thus, read as a whole, claim 23 recites a system comprises a first device on the internal network, a second device coupled with both the internal and the external networks, an intermediary facilitating communication between the first and second devices.

The Examiner cites Fig. 1 of Cho as teaching of the second device in claim 23. However, Cho does not disclose that the second device is coupled with the internal and external network.

Buch is cited as teaching an end-to-end authentication mechanism, and Ellison is cited as teaching the need for a security model which need was recognized by the UPnP Forum, and in combination as teaching the request for the initiation of a secure communication session in claim 23. However, Buch and Ellison fail to cure above stated deficiency of Cho.

Accordingly, the combination of Cho, Buch, and Ellison fails to teach or suggest each and every element of claim 23 and claim 23 is patentable over Cho, Buch, and Ellison under 35 U.S.C. § 103(a).

Claims 25 and 26 depend from claim 23, incorporating its recitations. Therefore, due to at least above stated reasons, claims 25 and 26 are also patentable over Cho, Buch, and Ellison under 35 U.S.C. § 103(a).

6. Claim Rejections – 35 USC § 103” item 8 on page 18 of the above-identified Office Action, claim 24 as being unpatentable over Cho, Buch, Ellison, and Le under 35 U.S.C. § 103(a).

Claims 24 depends from claim 23, incorporating its recitations. The firewall in Le is cited as teaching elements with regards to the filter of the intermediary in claim 24. However, Le fails to cure the above stated deficiencies of Cho, Buch, and Ellison. So, claim 24 is patentable over Cho, Buch, Ellison, and Le under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, reconsideration and allowance of the pending claims are solicited. As a result of the amendments made herein, Applicants submit that the pending claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
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